

Applicant: David S. Lawrence
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REMARKS

Claims 49, 56-71, 73-80, 82-84, 86-102, 122-123, 127-131, 133-134, 137-143 and 146-147 were pending in the subject application. Dependent Claims 70, 79, 80, 82, 84, 92, 93, 94, 96 and 101 are withdrawn from consideration by the Examiner as directed to non-elected species. By this Amendment, Claims 56, 57, and 59-63 have been amended, and new Claim 184 has been added. Applicant maintains that the amendments do not raise an issue of new matter. Support for new Claim 148 can be found at least in the previous version of Claim 56. Support for the remaining claim amendments can be found at least in the previous version of the claims. Accordingly, entry of the amendment is respectfully requested.

Claim Objections

1. Claim 57 is objected to because the Examiner indicated that it has the same scope as Claim 56. In reply, Claim 56 has been amended to remove the subject matter of Claim 57, thereby obviating this objection.
2. Claim 88 and dependent Claims 140 and 141 are objected to because the Examiner indicated that the chemical structures [in Claim 88] are represented by straight lines and one skilled in the art would not be able to discern how many carbon bonds are represented by the structure.

Applicant respectfully traverses this objection. Applicant notes that the structures are written with the peptides shown in schematic form with the side chain functionality explicitly representing the amino acid moiety. Applicant maintains that one skilled in the art would recognize, for example, that the guanidino group is representative of the arginine side chain. As a specific example, the application indicates on page 41 that the compound labeled number 21 in Table 3 [which is compound 21 in Claim 88] is the same

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as compound 2 in Example I, which is also shown in Scheme 2, where the side chains are indicated. Compound 2 of Example I is identified, for example, in paragraph [0090] on page 29 of the application as 7-nitrobenz-2-oxa-1,3-diazole (NBD)-NH-Ser-Phe-Arg₄-Lys-amide. In addition, the fact that the structures were published online as part of a peer-reviewed paper is further indication that the skilled artisan knows what the structures mean. See online Data Supplement for Journal of Biological Chemistry: Volume 277, Issue 13 -- Page 11527 (Yeh et al. 2002). A printout of this online Data Supplement was previously provided to the Patent Office as part of a Declaration of David S. Lawrence under 37 C.F.R. §1.131, which was submitted with applicant's reply dated April 16, 2007. Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Rejections under 35 U.S.C. §102(b)

Claims 49, 56, 60-69, 73-78, 83, 86, 87, 123, 134 and 137-139 are rejected under 35 U.S.C. §102(b) as being anticipated by Chen et al. (J. Am. Chem. Soc., 124: 3840-41, 12 Apr 2002, published on internet 22 Mar 2002).

Applicant respectfully traverses this rejection. Chen et al., which is authored by the applicant and his coworkers, was published online on March 22, 2002, which is less than one year before the January 10, 2003 filing date of priority document U.S. Provisional Patent Application No. 60/439,359.

Applicant notes that the issue of Chen et al. as the basis for a rejection under 35 U.S.C. §102(a) was previously addressed in applicant's reply dated April 16, 2007 and the Declaration of David S. Lawrence under 37 C.F.R. §1.132, which was submitted with the April 16, 2007 reply. Earlier rejections based on Chen et al. were withdrawn in view of this previous reply. The Examiner is referred to these earlier submissions.

Reconsideration and withdrawal of this rejection is respectfully requested.

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Rejections under 35 U.S.C. §102(e)

Claims 49, 56-69, 71, 73-77, 83, 86-91, 95, 97-100, 102, 122-123, 127-131, 133-134, 137-143, 146 and 147 are rejected under 35 U.S.C. §102(e) as being anticipated by Nguyen et al., U.S. Patent Application Publication No. US 2004/0166553.

Reconsideration and withdrawal of these rejections are respectfully requested in view of applicant's reply dated April 16, 2007 and the Declaration of David S. Lawrence under 37 C.F.R. §1.131, which was submitted with the April 16, 2007 reply. Earlier rejections based on Nguyen et al. were withdrawn in view of this previous reply. The Examiner is referred to these earlier submissions.

Request for re-instatement of withdrawn species claims

Upon allowability of an independent claim, re-instatement and consideration of withdrawn dependent species claims are respectfully requested (37 CFR §1.141, MPEP §806.04(d)).

Supplemental Information Disclosure Statement

This Information Disclosure Statement is being filed to supplement the Information Disclosure Statements filed on May 7, 2008, November 8, 2007, April 16, 2007, January 9, 2004, May 24, 2005 and July 26, 2005 in connection with the subject application. In accordance with the duty of disclosure under 37 C.F.R. §1.56, applicant would like to direct the Examiner's attention to the reference listed on attached Form PTO/SB/08A (1 page).

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CONCLUSIONS

In view of the amendments and remarks made hereinabove, reconsideration and withdrawal of the objections and rejections set forth in the November 12, 2008 Office Action and passage of the pending claims to allowance are respectfully requested. If there is any minor matter preventing the allowance of the subject application, the Examiner is requested to telephone the undersigned attorney.

A check for \$ 310.00 is enclosed for (i) the \$130.00 fee for a one month extension of time and (ii) the \$180.00 fee for submitting an Information Disclosure Statement. No additional fee is deemed necessary in connection with the filing of this response. However, if any other fee is required with this reply or to preserve the pendency of the subject application, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 01-1785.

Respectfully submitted,

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By 
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